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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,251	04/03/2001	Mutsuo Nishi	084437/0143	1311

22428 7590 09/16/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/16/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

Office Action Summary	Application No. 09/824,251	Applicant(s) NISHI ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments, remarks and declaration filed on 7/18/2003. Applicant's declaration and amendments to claims 5, 18-20 and 22 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Election/Restrictions

4. Newly amended claims 18 and 22 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

It is noted that claims 18 and 22 were originally directed to a "porous polyester film", having certain "use" clauses attached thereto, whereas newly amended claim 18 is now directed to a "display reflector", and newly amended claim 22 is now directed to an "electric insulator". The Examiner notes that these newly amended claims now appear to be clearly unrelated inventions of different scope and classification.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18 and 22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

5. Claims 10, 11, 15 16 and 20 are objected to because of the following informalities:

In claims 10, 11 and 20, the Examiner suggests to change the terms "main" and "mainly" to --major-- and --substantially--, respectively, so as to clearly claim the limitations.

In claims 15 and 16, the Examiner suggests to delete "a" from the phrase "a light", since it appears to be a grammatical error.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In newly amended claim 19, line 3, the phrase "20 wt%" is vague and indefinite, i.e., it is not clear as to the basis of the weight percentage.

Response to Amendment

7. With respect to the newly amended Title "The Use of a Porous Polyester Film", the Examiner notes that since the independent claim 1 is clearly directed to an article "a porous polyester film", the Examiner would like to respectfully suggests that the original Title "Porous Polyester Film" appears more appropriate.

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8. Claims 1-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (EP 0 884 347 A2), substantially for the reasons set forth in section 4 of Paper No. 6, together with the following additional observations.

First, in view of the fact that Sasaki is a co-inventor of the instantly claimed invention, and also that both the Sasaki reference and instant invention have the same assignee, i.e., Toyo Boseki Kabushiki Kaisha, on the record, the Sasaki U.S. Patent 6,096,684 reference is now disqualified as prior art under 35 U.S.C. 103(c). See MPEP § 706.02(a). However, it is noted that its apparent identical EP '347 is still a valid prior art reference. As such, the Examiner has substituted EP '347 as the basis of the prior art rejection.

With respect to Applicants' Response arguing that "the void-containing polyester films of Examples 1-12 of the Sasaki reference was less than 0.20 void/ μm " and "the Sasaki reference does not teach or suggest all of the claimed limitations" (Remarks, page 6, 3rd paragraph), the Examiner reiterates (see Paper No. 6, page 3) that it is noted that Sasaki teaches that the mixing percentage of the incompatible thermoplastic resin relative to polyester depends on a desired amount of voids. It is preferably 3-20 wt % of the film as a whole. When it is less than 3 wt %, the amount of voids cannot be increased to a desired level. When it exceeds 20 wt %, the film is caused to have poor stretch property, lower heat resistance and less strength (pages 4-5, bridging paragraph). As such, in the absence of unexpected results, it appears that Sasaki teaches the entire applicable range of the void forming incompatible thermoplastic resins, and it is believed that a suitable void/thickness ratio is either also inherently

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encompassed by Sasaki's teaching, or an obvious optimization to one skilled in the art, motivated by the desire to obtain a high quality image-receiving sheet. Note also as evidence of the state of the art EP 0 672 536 A2, which is directed to a thermal transfer image-receiving sheet, and EP '536 teaches that a suitable range of number of microvoids is 3.7×10^4 to $2.2 \times 10^5/\text{mm}^2$ (page 4, lines 46-55), i.e., 0.192 to 0.469/ μm in a linear direction, which clearly read on the number of voids in a thickness direction of the instantly claimed invention as well, since the polymer melt would inherently have a homogeneous distribution of the pore former (i.e., incompatible thermoplastic resins) in any direction in the bulk phase.

With respect to Applicants' argument that Table 1 of the Declaration shows that the films of Sasaki have less than 0.2 void/ μm (Remarks, page 6, 3rd paragraph), the "Sasaki reference did not conform to the formula recited in claim 11 of the present invention because the ratio (η_o/η_s) exceeded 0.8" (Remarks, page 6, bottom paragraph), and in order to meet the limitation of the ratio of the number of voids to film thickness of not less than 0.20 void/ μm , "the ratio (η_o/η_s) ... must not be more than 0.8" (Remarks, page 7, top paragraph), the examiner reiterates (see Paper No. 6, page 4) that while Sasaki does not expressly teach the melt viscosity ratio of polyolefin and polystyrene, it is noted that Sasaki teaches a porous polyester film forming process which is essentially the same as the instant claimed invention. As such, it is believed that in order to form a desired amount of voids, a suitable melt viscosity ratio of the incompatible resins is either inherently disclosed by Sasaki, or an obvious optimization to one skilled in the art. Note also as evidence the state of the art EP 0 672 536 A2,

which clearly read on the number of voids in a thickness direction of the instantly claimed invention as set forth above.

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1900~~
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Daniel Zinker